

REMARKS

In this office action the Examiner indicated that a provisional election had been made in an Election/Restriction during a phone conversation and that affirmation of the election must be made in response to this office action.

Applicant affirms the intent to prosecute the invention of Group I, claims 1-18 and 22. Claims 19-21 are withdrawn.

The Examiner objected to the drawings under 37 CFR 1.83(a) for failing to show every feature of the invention specified in the claims. The Examiner stated, "Therefore, the nonskid surface on the first and second sides of the first member (claims 4,5), the adjustable diameter of the ring in the second member (claim 9), the means to prevent slipping of the ring in the second member (claim 10) must be shown or the feature(s) cancelled from the claims. No new matter may be entered."

Applicant has submitted new Figures 9-12 showing the adjustable diameter of the ring, the nonskid surfaces on both sides of the first member and the means to prevent the ring from slipping. Therefore, Applicant respectfully requests that the Examiner withdraw the objection to the drawings under 37 CFR 1.83(a) for failing to show every feature of the invention specified in the claims.

The Examiner also objected to the drawings under 37 CFR 1.121(d) because Figure 6 show(s) modified forms of construction in the same figure. The Examiner indicated that corrected drawing

sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application.

Applicant has added a new sheet with Figures 7 and 8 displayed thereon where the modified forms of construction are shown in separate Figures and are not shown on the same Figure. Therefore, Applicant respectfully requests that the Examiner withdraw the objection to the drawings under 37 CFR 1.121(d) because Figure 6 show(s) modified forms of construction in the same Figure.

The Examiner rejected claims 9-12 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The examiner stated, "The claims contain subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 9 recites an adjustable diameter but this is not shown and the specification does not describe how this is accomplished. Claim 10 recites a means to prevent slipping but this is not shown and the specification does not disclose any means for accomplishing this. Claims 11 and 12 are dependent on claim 10."

Applicant has amended the specification to include a description of the items detailed by the Examiner and, further, Applicant has submitted new drawing Figures 7-12 for the Examiner's approval. No new matter was added. Therefore, Applicant respectfully requests that the Examiner withdraw the rejection of

claims 9-12 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.

The Examiner rejected claims 1,2,3,6 and 7 under 35 U.S.C. 102(b) as being anticipated by Overkamp (6,305,532). The Examiner stated, "Overkamp discloses a lap tray having a generally rectangular first member (10, Figure 1, column 4, lines 36-38) with a second member for holding a fluid container that includes a cavity located near an outer edge of the first member (40, column 4, lines 46-48) and the second member includes a ring like member that can be disposed therein (80, Figures 3,4 column 4, lines 63-65)."

Applicant has amended claim 1 to include the limitations defined in claim 8 which now includes the limitation that "said second member further includes a first plurality of gear like members secured to one of an inner surface and an outer surface of said second member, said first plurality of gear like members having a first predetermined pitch for engagement with a second plurality of gear like members having a substantially identical pitch as said first plurality of gear like members and disposed on an opposite one of an outer surface and an inner surface of a predetermined portion of such specially configured fluid container". Thus the present invention provides for gear like members disposed on or in the second member depending on whether the second member is a cavity as would occur if the first member is a lap top tray or as a projection as would be if the first member

is a place mat. The present invention requires that there also be a plurality of gear like members on the specially configured beverage container so as to mesh with the gears in the second member. Thus, the gears on the beverage container would engage the gears on the second member simply by twisting and thus secure the beverage container and prevent it from tipping. A simple reverse twist would disengage the gears and the beverage container could be removed from the second member.

There is no teaching or even any suggestion as to the presence of gear like members in the aperture as taught by Overkamp, nor does Overkamp make any mention or suggestion of having a specially configured beverage container.

Therefore, Applicant respectfully requests that the Examiner withdraw the rejection of claims 1,2,3,6 and 7 under 35 U.S.C. 102(b) as being anticipated by Overkamp (6,305,532).

The Examiner also rejected claims 1 and 8 under 35 U.S.C. 102(b) as being anticipated by Torkelson (5,607,077). The Examiner stated, "Torkelson discloses an apparatus with a first member (10, Figure 1, column 4, lines 19-21) with a second member for holding a fluid container (34, Figure 1, column 4, lines 58-60) and the second member has a plurality of gear like members secured to an inner surface (64, Figure 5a, column 6, lines 13-18)."

As stated previously Applicant has amended claim 1 to include the limitations defined in claim 8, and which now includes the limitation that "said second member further includes a first

plurality of gear like members secured to one of an inner surface and an outer surface of said second member, said first plurality of gear like members having a first predetermined pitch for engagement with a second plurality of gear like members having a substantially identical pitch as said first plurality of gear like members and disposed on an opposite one of an outer surface and an inner surface of a predetermined portion of such specially configured fluid container". Thus, the present invention provides for gear like members disposed on or in the second member depending on whether the second member is a cavity as would occur if the first member is a lap top tray or as a projection as would be if the first member is a place mat. The present invention requires that there also be a plurality of gear like members on the specially configured beverage container so as to mesh with the gears in the second member. Thus, the gears on the beverage container would engage the gears on the second member simply by twisting and thus secure the beverage container. A simple reverse twist would disengage the gears and the beverage container could be removed from the second member easily.

There is no teaching or even a suggestion in Torkelson of the presence of gears on the beverage compartment. The Examiner refers to "the second member has a plurality of gear like members secured to an inner surface". However, the projections 46, as seen in Figure 5a, which the Examiner says are gears is really a conclusion on the part of the Examiner and is not supported by the teaching of

Torkelson. Torkelson states, "The beverage container compartment 34 may further include a plurality of ribs 64 placed along the interior of the peripheral surface 36. The ribs 64 allow for tighter fit between the container and the compartment 34 but dispense enough suction forces to allow easy removal of the container." Thus, the ribs 64 of Torkelson have to be flexible and are probably elastomeric so as to permit the ribs to form a tight fit around the container and further to permit the container to be removed easily. Gears are not flexible, as such, and further the gears as defined in amended claim 1 require a specially configured beverage container having gears on the lower surface to engage the gears in the second member and thus retain the container and prevent it from tipping. Torgelson neither teaches such a configuration nor even suggests it.

Applicant has cancelled claim 8 since its limitations were incorporated into claim 1. Therefore, Applicant respectfully requests that the Examiner withdraw the rejection of claim 1 under 35 U.S.C. 102(b) as being anticipated by Torkelson (5,607,077).

The Examiner rejected claim 22 under 35 U.S.C. 102(b) as being anticipated by Ercolini (5,119,967). The Examiner stated, "Ercolini discloses an apparatus having a first member (10, Figure 1, column 2 49-51), a second member for holding a fluid container (20, column 3, lines 3-5) and a third member for holding a food container."

Applicant has amended claim 22 to include the limitations that were defined in claim 8, which provides gear like members in such second member for engagement with gear like members on such specially configured beverage container. There is no teaching or even a suggestion in Ercolini about gear like members in such second member. Therefore, Applicant respectfully requests that the Examiner withdraw the rejection of claim 22 under 35 U.S.C. 102(b) as being anticipated by Ercolini.

Further in the office action the Examiner rejected claims 13 and 14 under 35 U.S.C. 103(a) as being unpatentable over Overkamp. The Examiner stated,

"Regarding claim 13, Overkamp discloses the apparatus of claim 7 but does not disclose any dimensions for the height of the ring. Applicant requires the height of the ring to be 1/8-1/2 inches but does not disclose that these dimensions are for any particular purpose or solve any stated problem. The apparatus of Overkamp would be inherently capable of performing in the same manner as the apparatus of claim 13. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the use of a height of 1/8-1/2 inches in the apparatus disclosed by Overkamp to provide it with adequate height to securely grasp the bottom of a container. In *Gardiner v. TEC Systems, Inc.*, 725F.2d 1338, 220 USPQ 777 (fed.Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the

claims was a recitation of the relative dimensions of a claimed device and a device having claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

Regarding claim 14, applicant requires a thickness for the ring member of 1/8"- 1/2" that relates to the preferred inner and outer diameters stated in the specification. Overkamp discloses the apparatus of claim 7 but does not disclose a thickness for the ring, however, Overkamp would be inherently capable of performing in the same manner as the apparatus of claim 14. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the use of a width of 1/8"-1/2" in the apparatus disclosed by Overkamp to provide it with adequate size to securely grasp the bottom of a typical container. The court holding as discussed in paragraph 17 applies."

Applicant has discussed previously that Overkamp does not teach gear like members as is claimed in amended claim 1 of the present invention and thus the thickness of the ring becomes a moot point since the ring is basically the thickness of the gear like members.

Therefore, Applicant respectfully requests that the Examiner withdraw the rejection of claims 13 and 14 under 35 U.S.C. 103(a) as being unpatentable over Overkamp.

The Examiner rejected claims 4 and 5 under 35 U.S.C. 103(a) as being unpatentable over Overkamp in view of French (2,777,626). The Examiner stated, "Overkamp discloses the apparatus of claim 1 but does not teach the use of non-skid material on a first or second side of the first member. French discloses a tray apparatus with a non-skid material on the top and bottom surfaces (25, 125, Figures 1 and 4, column 1, lines 46-50, lines 68-70, column 2, lines 51-55) to provide anti-skid properties for the tray and its contents. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the use of a non-skid material on the top and bottom surfaces of the apparatus as disclosed by French in the apparatus disclosed by Overkamp to provide anti-skid properties for the apparatus and its contents."

Applicant has discussed previously that Overkamp does not disclose the apparatus of claim 1 since amended claim 1 provides for gear like members in such second member which engage similar gear like members on a specially configured beverage container. Such configuration is not taught by Overkamp, thus, even if French discloses the use of non-skid material it does override the fact that the basic invention is different from that taught by Overkamp.

Therefore Applicant respectfully requests that the examiner withdraw the rejection of claims 4 and 5 under 35 U.S.C. 103(a) as being unpatentable over Overkamp in view of French (2,777,626).

The Examiner rejected claim 9 under 35 U.S.C. 103(a) as being unpatentable over Overkamp in view of Burrows et al (5,170,980). The Examiner stated, "Overkamp discloses the apparatus of claim 7 but does not teach that the ring member is adjustable. Burrows et al discloses a fluid container ring that is adjustable for different size containers (Figures 7 and 8, column 5, lines 3-11). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the use of a fluid container ring that is adjustable as disclosed by Burrows et al in the apparatus disclosed by Overkamp to allow its use with different size containers."

Applicant has discussed previously that Overkamp does not disclose the apparatus of claim 1 since amended claim 1 provides for gear like members in such second member which engage similar gear like members on a specially configured beverage container. Such configuration is not taught by Overkamp. Further, the adjustable ring of the present invention is adjustable for different size openings or apertures not for different size beverage containers. Thus, even if Burrows provides a configuration which is adjustable for different size containers it does override the fact that the basic invention is different from that taught by Overkamp.

Therefore, Applicant respectfully requests that the examiner withdraw the rejection of claim 9 under 35 U.S.C. 103(a) as being unpatentable over Overkamp in view of Burrows et al (5,170,980).

The Examiner then rejected claims 10-12 under 35 U.S.C. 103(a) as being unpatentable over Overkamp in view of Lin (2002/0134903, September 26, 2002). The Examiner stated, "Overkamp discloses the apparatus of claim 7 but does not teach the use of a means to prevent slipping on the ring. Lin discloses the use of a resilient pad on the bottom of a fluid container holder to form a non-slip substructure to increase stability and prevent slipping (50, Figures 13,14 and paragraph 0037). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the use of a resilient pad on the bottom of a fluid container ring to form a non-slip substructure as disclosed by Lin in the apparatus disclosed by Overkamp to increase stability and prevent slipping."

As discussed previously, Applicant has amended claim 1 to include the limitations of claim 8 which provides for a plurality of gear like members secured to second member for engagement with a second plurality of gear like members on a specially configured beverage container. Since this configuration is not taught by Overkamp, Applicant respectfully requests that the examiner withdraw the rejection of claims 10-12 under 35 U.S.C. 103(a) as being unpatentable over Overkamp in view of Lin (2002/0134903, September 26, 2002).

The Examiner rejected Claims 17 and 18 under 35 U.S.C. 103(a) as being unpatentable over Overkamp in view of Bryant (6,371,322). The Examiner stated, "Overkamp discloses the apparatus of claim 1

but does not teach a material for it. Bryant discloses a tray apparatus (10, Figure 1) and that the apparatus may be made from polyvinyl chloride, PVC, (column 3 lines 59-62). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the use of polyvinyl chloride as disclosed by Bryant in the apparatus disclosed by Overkamp to use a rigid, durable material that is commonly used and whose forming is known in the art."

Applicant wishes again to point out that none of the prior art references cited by the Examiner teach a plurality of gear like disposed in a ring on a member that engage a second plurality of gear like members on a specially configured beverage container so as to prevent tipping of the beverage container. The fact that Bryant discloses the use of polyvinyl chloride does not alter the face that the basic unit is different from anything taught or even suggested by Overkamp.

Therefore, Applicant respectfully requests that the Examiner withdraw the rejection of claims 17 and 18 under 35 U.S.C. 103(a) as being unpatentable over Overkamp in view of Bryant (6,371,322).

The Examiner rejected claims 15 and 16 under 35 U.S.C. 103(a) as being unpatentable over Torkelson in view of Wilde et al (4,418,828) and Ma (6,766,916). The Examiner stated, "Torkelson discloses the apparatus of claim 8 but does not teach that the gear like members are disposed at a specified angle. Wilde et al discloses a locking ring that is positioned around a container neck

and has gear like members (34, 42, Figure 1 and 3, and column 7, lines 54-58). The gear like members are disposed at an angle of 20-60 degrees with respect to the vertical (column 7 line 67 to column 8 line 5 and column 8 lines 12-15), which would be 30 -70 degrees with respect to the horizontal, which allows application of a closure with the locking ring to a container without interference from the ring. Ma discloses first and second gear like members on mating surfaces of the locking ring and the container that have substantially identical pitch (Figures 13-16 and column 6, lines 17-50). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the use of first and second gear like members disposed at an angle of 20-60 degrees with respect to the vertical, which is 30 -70 degrees with respect to the horizontal, as disclosed by Wilder et al and Ma in the apparatus disclosed by Torkelson to allow application of the locking ring to a container without interference from the ring."

As discussed previously the "gear like members" which the Examiner states is disclosed by Torkelson, are not really gear like members but are flexible ribs or projections which provide a tighter fit between the container and the compartment but dispense enough suction force to allow easy removal of the container. Further such pilfer band or threads on the neck of containers as taught by Wilde et al. and Ma have little application to the gears disposed on the bottom of a specially configured container for

engagement with gear like members disposed in or on a second member for securing such beverage container.

Therefore, Applicant respectfully requests that the Examiner withdraw the rejection of claims 15 and 16 under 35 U.S.C. 103(a) as being unpatentable over Torkelson in view of Wilde et al (4,418,828) and Ma (6,766,916).

Applicant wishes to point out that 9 different references were used by the Examiner in the rejection of the present invention. This would strongly suggest that such an invention is not very obvious to one of ordinary skill in the art.

In view of the amendment to the claims and the discussion supra it is believed that claims 1-7 and 9-18 and 22 are patentable. Therefore, Applicant believes that this application is now in condition for allowance and such allowance by the Examiner is respectfully requested.

In the event the Examiner has further difficulties with the examination and/or allowance of the application, the Examiner is invited to contact the undersigned agent for applicant by telephone at (412)380-0725, if necessary, to resolve any remaining questions or issues by interview and/or Examiner's Amendment as to any matter.

Respectfully submitted,

By Amos Bartoli
Amos Bartoli
Registration No. 42,299
Agent for Applicant

JAMES RAY & ASSOCIATES
2640 Pitcairn Road
Monroeville, PA 15146

Tel. (412) 380-0725
Fax (412) 380-0748